

REMARKS

This application was originally filed on 9 November 2001 with sixteen claims, two of which were written in independent form. Claims 1, 4-6, and 13-15 have been amended, Claim 16 canceled, and Claims 17-30 added by this amendment. The accompanying amendments to the claims are intended to broaden the scope of the claims. Please charge any necessary fees to the deposit account of Texas Instruments Incorporated, Deposit Acct. No. 20-0668.

Claim 6 was objected to for using the term "plane" while the term "focal plane" was used in the specification. The applicant has amended Claims 6 and 13 to insert the word "focal."

Claims 1 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,369,933 to O'Callaghan. The applicant respectfully disagrees.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham and Adams*." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it." *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against

the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.

With respect to independent Claim 1, the Examiner has failed to provide a factual basis for the rejection. The Examiner stated, "there is disclosed in col. 12 lines 6-18, the use of apertures placed at or near the surface of the SLM's." The applicant respectfully disagrees. O'Callaghan states "apertures . . . are placed at the surface of mirrors 129 and 132" and "Apertures are also placed over lenses 120, 122, and 124" Thus, O'Callaghan does not show, teach, or suggest "an aperture spaced apart from said cover between said cover and said spatial light modulator" as recited by Claim 1.

The Examiner further stated, "There is no discussion of the type of packaging but this is an obvious design choice that one familiar with the background discussion in the specification and fig. 1 would know how to configure." The applicant respectfully disagrees and submits the Examiner has not provided any factual basis or suggestion in the art for the conclusory claim of "an obvious design choice."

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

With respect to Claim 12, the Examiner stated, "the improvement being the aperture placement and would be obvious as discussed with reference to claim 1." The applicant disagrees for the reasons discussed above with respect to Claim 1.

Without a factual basis for the rejection or a line of reasoning as to why the artisan would have found the claimed invention to have been obvious, the Examiner's rejection is unsupported by the prior art, fails to establish a prima facie case of obviousness, and therefore should be withdrawn.

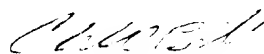
Claims 2-5, 7, 8, 11, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Callaghan. Claims 9, 10, 14, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Callaghan in view of U.S. Patent No. 5,939,785 to Klonis et al. ("Klonis").

The applicant respectfully disagrees. Claims 2-5, 7-11, and 13-15 depend from Claims 1 and 2 and should be deemed allowable for that reason and on their own merits.

Newly added Claims 17-30 should be deemed allowable for reasons similar to those discussed above with respect to Claims 1 and 12.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application, Claims 1-15 and 17-30, accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that Claims 1-15 and 17-30 are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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